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1722

THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION EXAMINING OPERATIONS

Appl. No.: 10/058,443 Confirmation No.: 7553
Applicant : Rebecca Klotzer
Filed : January 22, 2002
TC/AU: 1722
Examiner: Del Sole

Docket No. : DES:3568.0076
Customer No.: 00152

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL REJECTION

1600 ODS Tower
601 S.W. Second Avenue
Portland, Oregon 97204-3157
Tel. 503.227.5631

November 20, 2003

Dear Sir:

In response to the Final Rejection of September 12, 2003, applicant points out that a Petition to Revive the parent application PCT/EP99/00286 for purposes of establishing priority was filed on September 17, 2003. Should this Petition be granted, priority will have been established and the basis for the outstanding Final Rejection under 35 USC 102(b) will have been removed.

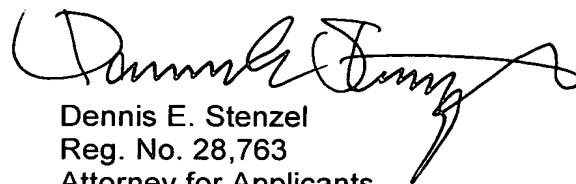
However, no action has yet been taken on the Petition to Revive. Since the shortened statutory period for response expires on December 12, 2003, applicant has

Appl. No.: 10/058,443
RESPONSE TO FINAL REJECTION dated November 20, 2003

filed concurrently herewith a Petition for Suspension of Action under 37 CFR 1.103 to stay further action in this application until the Commissioner has ruled upon applicant's Petition to Revive. For convenience of the Examiner's reference, copies of both the Petition to Revive and the Petition to Suspend Action are enclosed herewith.

Dated this 20th day of November, 2003.

Respectfully submitted,



Dennis E. Stenzel
Reg. No. 28,763
Attorney for Applicants
Tel: (503) 227-5631

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO FINAL REJECTION, together with a Certificate of Mailing and Return Acknowledgment Postcard, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 20th day of November, 2003.



Dennis E. Stenzel



COPY

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PATENT APPLICATION EXAMINING OPERATIONS

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Applicant : Rebecca Klotzer
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Docket No. : DES:3568.0076
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Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR SUSPENSION OF ACTION

1600 ODS Tower
601 S.W. Second Avenue
Portland, Oregon 97204-3157
Tel. 503.227.5631

November 20, 2003

Dear Sir:

Pursuant to 37 CFR 1.103(a) applicant hereby petitions for suspension of action by the Office for a period not exceeding six months or until the Commissioner decides applicant's Petition to Revive filed September 17, 2003, whichever comes first.

As grounds for this Petition, applicant shows as follows.

Appl. No.: 10/058,443

PETITION FOR SUSPENSION OF ACTION dated November 10, 2003

1. A Final Rejection of all of the claims in the application was issued on September 12, 2003, making the deadline for response without payment of a late filing fee December 12, 2003.

2. The grounds for the Final Rejection was that applicant's own prior application DE 198 03 362.1, the priority of which applicant claimed in the instant application, became prior art by virtue of applicant having failed to file the instant PCT National Phase application within 30 months of the filing date of DE 198 03 362.1, thereby causing the parent PCT application PCT/EP99/00286 to become abandoned 20 days before the filing of the instant PCT National Phase application. A copy of the Final Rejection is attached hereto as Exhibit A.

3. On September 17, 2003, applicant filed a Petition to Revive the parent PCT application PCT/EP99/00286 on the ground that the abandonment was unintentional. A copy of that Petition to Revive is attached hereto as Exhibit B.

4. A favorable decision on the aforesaid Petition to Revive will permit applicant to claim priority of DE 198 03 362.1, which will remove the published version of this German application as prior art under 35 USC 102(b). However, a decision on the Petition to Revive has not yet been rendered by the Commissioner.

5. A Response to the outstanding Final Rejection was filed on November 10 2003; a copy of the same is attached hereto as Exhibit C.

As detailed above, the essential reason for the instant Petition for Suspension of Action is the failure of the Office to act on applicant's Petition to Revive in a timely manner. For that reason, it is believed that the fee set forth in §1.17(h) is not required. In the event the Office disagrees, the Commissioner is hereby authorized to

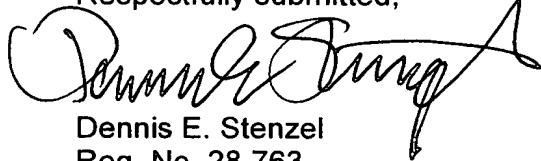
Appl. No.: 10/058,443

PETITION FOR SUSPENSION OF ACTION dated November 20, 2003

charge the \$130 fee specified in §1.17(h) to Deposit Account 03-1550 and credit any overpayments to the same account. A duplicate copy of this Petition is enclosed.

Dated this 20th day of November, 2003.

Respectfully submitted,



Dennis E. Stenzel
Reg. No. 28,763
Attorney for Applicants
Tel: (503) 227-5631

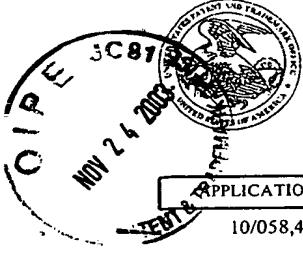
CERTIFICATE OF MAILING

I hereby certify that this PETITION FOR SUSPENSION OF ACTION, together with a Certificate of Mailing and Return Acknowledgment Postcard, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 20th day of November, 2003.



Dennis E. Stenzel

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,443	01/22/2002	Rebecca Klotzer	3568.076	7553

152 7590 09/12/2003

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
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SEP 15 2003

CHERNOFF, VILHAUER,
MCCLUNG & STENZEL

DES

EXAMINER

DEL SOLE, JOSEPH S

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 09/12/2003

Expanded Porous Thermoplastic Polymer Membranes and Method/Device
Please find below and/or attached an Office communication concerning this application or proceeding.

DES
DUCKETED: 12/12/03 *Final*
REMINDER: 11/12/03
By [Signature]



Office Action Summary

Application No.

10/058,443

Applicant(s)

KLOTZER, REBECCA

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears in the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
- 1.) Certified copies of the priority documents have been received.
- 2.) Certified copies of the priority documents have been received in Application No. 09/642,390.
- 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application (PCT/EP99/00286) under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. However, copendency has not been achieved. In order for copendency to be achieved the filing date of the parent application, 09/642,390, must be within 30 months of the filing of the parent application, DE19803361.1. 09/642,390 was filed on 8/18/2000, which is 30 months and 20 days after the filing of ~~DE~~ DE19803361.1. Since the filing date of 09/642,390 is more than 30 months past the priority date, PCT/EP99/00286 was abandoned before filing of the US case and copendency was not achieved.

Since copendency has not been achieved, the effective filing date of the present application is 8/18/2000. Therefore, publication DE19803362A1, which was published on 8/5/1999 is eligible as prior art under 35USC102(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Klotzer (DE19803362A1).

Klotzer teaches an apparatus having an extruder equipped with a metering apparatus and heating elements to form a polymer melt, the extruder having a cylinder connected via a first melt pump to a die for extrusion, an injection stage before the first melt pump, a heat exchanger located between the first melt pump and the die to form a second mixing stage, a second melt pump located upstream from the die; the heat exchanger is equipped with a mixer; the mixer is a static mixer; the injection stage has metering pumps that are connected via hollow needles and plates so as to be in fluid communication with the cylinder of the extruder; the metering pumps are equipped with coolable pump heads and the die is configured as a wide-slit nozzle.

Response to Arguments

4. Applicant's arguments filed 8/29, 2003 have been fully considered but they are not persuasive.

The Applicant argues that 35 USC 363 provides that the filing date of an International Application designating the United States is also the filing date of corresponding U.S. National application. The Applicant further argues that the proper filing date of parent application 09/642,390 was January 19, 1999.

The Examiner disagrees. 35 USC 363 provides that an international application designating the U.S. shall have the effect, from its international filing date, of a national application for patent regularly filed. Therefore, PCT/EP99/00286 has the effect of a national application, and thus is taken to have an effective U.S. filing date equal to its

international filing date. However, the Applicant's statement that "the filing date... is also the filing date of corresponding U.S. National application" is not true in this instance. As discussed by the Examiner in the Office action of 8/12/03, the current application 10/058,443 fails to correspond properly as a continuing application of prior application PCT/EP99/00286 because 09/642,390 was not filed while PCT/EP99/00286 was still pending. In order to have the benefit of the filing date of PCT/EP99/00286, PCT/EP99/00286 would had to have still been pending at the time that application 09/642,390 was filed. PCT/EP99/00286 was only pending for the period of 30 months after the filing of DE19803361.1 (filing date: 29 January 1998). Therefore, pendency of PCT/EP99/00286 ended 29 July 2000. Since 09/642,390 was filed 18 August 2000, it could not claim as its effective filing date the filing date of PCT/EP99/00286 and therefore the effective filing date of current application 10/058,443 is 18 August 2000. See MPEP 1895.01 II and 37CFR1.495(b).

The Applicant further argues that according to MPEP 1895.01 provides that a foreign priority claim is proper if (1) a claim for foreign priority was made in the international application, and (2) the foreign application was filed within 12 months prior to the international filing date.

These arguments are incomplete with regard to the Examiner's comments regarding priority and to the Examiner's explanation for the applicability of applying 35USC102(b) rejections. MPEP 1895.01 II states the full requirements, including that the continuing application (09/642,390) must be filed before the international application

(PCT/EP99/00286) becomes abandoned as to the U.S as set forth in 37 CFR 1.495. 37 CFR 1.495 (b) states:

To avoid abandonment of the application, the Applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

- (1) A copy of the international application, unless it has been previously communicated by the Internationally Bureau or unless it was originally filed in the United Stated Patent and Trademark Office; and
- (2) The basic national fee (see 1.492(a)).

Therefore, the international application was abandoned and the effective filing date of applications 09/642,390 and 10/058,443 stands as 18 August 2000. The Examiner notes that the Applicant has not argued this issue of a lack of copendency between 09/642,390 and PCT/EP99/00286.

The Applicant further discusses the relationship between PCT/EP99/00286 and DE19803362.1. This point is moot, since the issue at hand is the relationship and lack of copendency between 09/642,390 and PCT/EP99/00286.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Del Sole whose telephone number is (703) 308-6295. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


J.S.D.
September 8, 2003



ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300 1700

9/11/03



COPY

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PATENT APPLICATION EXAMINING OPERATIONS

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Applicant : Rebécca Klotzer
Filed : January 22, 2002
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Docket No. : DES:3568.0076
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Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO REVIVE PARENT PCT APPLICATION

1600 ODS Tower
601 S.W. Second Avenue
Portland, Oregon 97204-3157
Tel. 503.227.5631

September 17, 2003

Dear Sir:

Pursuant to 37 CFR 1.137(b), applicant hereby petitions the Commissioner for revival of parent application PCT/EP99/00286 for purposes of claiming priority of that PCT application only and shows as follows.

Application No. 10/058,443

PETITION TO REVIVE PARENT PCT APPLICATION dated September 17, 2003

1. The instant application Serial No. 10/058,443 was filed as a divisional of U.S. Application Serial No. 09/642,390 filed August 18, 2000 and claims priority of PCT EP99/00286 filed January 19, 1999 and DE 198 03 362.1 filed January 29, 1998.

2. On September 12, 2003 a final rejection of the instant application was issued, holding that parent application PCT/EP99/00286 had become abandoned as to the United States on July 29, 2000 by virtue of U.S. Application Serial No. 09/642,390 having been filed 20 days past the 30 month deadline for entering the national phase as to the United States, as measured from the January 19, 1998 filing date of DE 198 03 362.1.

3. Because the Examiner held that PCT/EP99/00286 became abandoned on July 29, 2000, he reasoned that the effective filing date of the instant application was August 18, 2000 (the filing date of parent application Serial No. 09/642,390) and that DE 198 03 362.1, which was published on August 5, 1999 as DE 198 03 326A, therefore qualified as prior art under 35 USC 102(b), and so finally rejected all claims of the instant application under 35 USC 102(b) as being anticipated by DE 198 03 362A1.

4. The proposed response constitutes entry into the national stage for the United States by filing a national entry application pursuant to 35 USC §371 and this proposed response was previously filed on August 18, 2000.

Application No.10/058,443

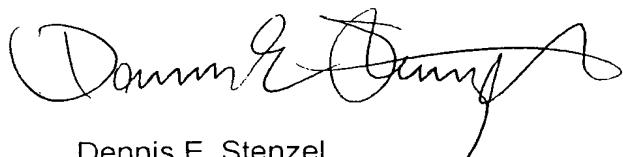
PETITION TO REVIVE PARENT PCT APPLICATION dated September 17, 2003

5. Both the 20-day delay in filing the national phase application from its due date of July 29, 2000 and the entire delay from that due date until the filing of this Petition was unintentional.

6. The \$1300 petition fee specified in 37 CFR 1.17(m) is enclosed herewith; the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account 03-1550.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Dated this 17th day of September, 2003.



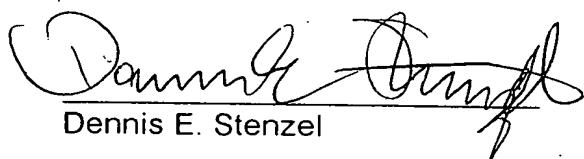
Dennis E. Stenzel
Reg. No. 28,763
Attorney for Applicants
Tel: (503) 227-5631

Application No. 10/058,443

PETITION TO REVIVE PARENT PCT APPLICATION dated September 17, 2003

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Dennis E. Stenzel



Receipt is hereby acknowledged by the USPTO of

**PETITION TO REVIVE PARENT PCT APPLICATION
Check No. IN THE AMOUNT OF \$1300
CERTIFICATE OF MAILING
RETURN ACKNOWLEDGMENT POSTCARD**



Applicant : Rebecca Klotzer
Serial No. : 10/058,443
Filed : January 22, 2002
Title : EXPANDED POROUS THERMOPLASTIC POLYMER
MEMBRANES AND DEVICE FOR THE PRODUCTION THEREOF

SARTORIUS/3568.076
DES/sjh
September 17, 2003

FIRST CLASS



U.S. POSTAGE PB 5520455
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CHERNOFF, VILHAUER, McCCLUNG & STENZEL, LLP

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